

REMARKS

The Office Action has maintained the restriction requirement, and has withdrawn Claims 18, 19 and 21 from further consideration. The Office Action acknowledges that applicants have chosen Group 2 of the restriction requirement. The Office Action has rejected Claims 2-17, and 20 under 35 U.S.C. §112, first paragraph, for allegedly being non-enabling. In addition, the Office Action has rejected Claims 1-17 and 20 under 35 U.S.C. §103 as defining subject matter which is allegedly rendered obvious by the teachings in an article by Wulff et al, The Physiologist, 1999, L12, pA-12 ("Wulff et al.").

Applicants have amended the claims, which, when considered with the comments herein, are deemed to place the present case in condition for allowance. Favorable action is respectfully requested.

Applicants have cancelled Claims 1-21 without prejudice. Applicants have not abandoned the subject matter therein, and reserve the right to file a continuation thereon.

In addition, applicants have added Claims 22-25 to the application. The claims have been amended to be consistent with the restriction requirement, i.e., A and B are furan rings, and the Linker is O-(CH₂)_n-O, wherein n is 4-9. Support can be found on page 9, lines 11-17 and Claim 3 of the original application.

No new matter is added to the application.

Pursuant to the rejection of the claims under 35 U.S.C. §112, first paragraph, the Office Action alleges that the specification is not enabling for the original subject matter, as originally claimed. However, it does admit that the application is enabling for compounds of Formula I, wherein the Linker is O-(CH₂)_n-O,, wherein n is 4-9 and A and B are fused furan rings and R₁=R₃=R₂=R₄=O-alkyl and R₅ =R₆ =COCH₃, i.e., the subject matter to which the

present application is directed, as amended.

Thus, the Office Action admits that the application, as amended, is enabled. Therefore, this rejection under 35 U.S.C. §112, first paragraph, is obviated.

Applicants agree that the subject matter, as amended, is enabled. But, applicants respectfully disagree that the subject matter, as originally filed, was not enabled. On the contrary, applicants respectfully submit that the claims, as originally filed, are enabled. For example, based on the Office Action's conclusion, using the rationale of the Office Action, homologs, as well as related subject matter, as originally filed, which, may be unsubstituted or optionally substituted, are also enabled.

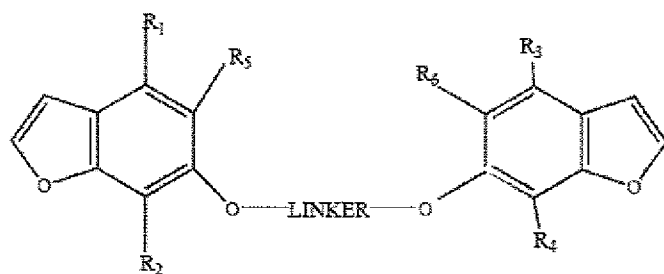
More specifically, even with respect to these homologs, and related subject matter, the breadth of the claims is narrow. These compounds are simple and can be prepared by methods known to one of ordinary skill in the art, even without any guidance from the specification. Nevertheless, the specification provides guidance on how to make these compounds. They are prepared similar to the methods in which the compounds wherein $R_1=R_3=R_2=R_4=\text{O-alkyl}$ and $R_5=R_6=\text{COCH}_3$ were made. The procedure used for making the compounds, wherein $R_1=R_3=R_2=R_4=\text{O-alkyl}$ and $R_5=R_6=\text{COCH}_3$ is representative. Further, given the similarity in structure, one of ordinary skill in the art predicts that these homologs and related subject matter also would have similar efficacy. Furthermore, the Office Action has not met its burden. Case law has held that a specification which contains a teaching in the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. §112, first paragraph, unless there is reason to doubt the objective truth or accuracy of the statements contained therein which must be

relied on for enabling support. In re Marzocchi, 439 F2d 220, 224, 169 USPQ 367, 370 (CCPA). As stated by the Marzocchi Court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertion of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." Id 439 F2d at 224, 169 USPQ at 370.

The Official Action did not provide any basis why it expects that the homologs and related subject matter would not have any utility – let alone provide any evidence in support thereof.

Thus, in conclusion, it is respectfully submitted that the subject matter, as claimed, as well as homologs and related subject matter, as originally claimed, are enabled by the instant specification. Thus, the present claims, as amended, are enabled, and the rejection under 35 U.S.C. §112, first paragraph, is obviated. Withdrawal thereof is respectfully requested.

Pursuant to the rejection of the claims under 35 U.S.C. §103, the Office Action alleges that the present application is unpatentable over Wulff et al. According to the Office Action, Wulff et al. teach the following dimeric Khellinone analogs as blockers of potassium channels:



wherein the Linker is $\text{CH}_2\text{-Ph-CH}_2$, Ph is benzene and $\text{R}_1=\text{R}_3=\text{R}_2=\text{R}_4=\text{O-alkyl}$ and $\text{R}_5=\text{R}_6=\text{COCH}_3$.

As the Office Action notes, one of the differences between the present invention, as claimed, and the teachings in Wulff et al. is in the Linker group, which in the present case, is $\text{O-(CH}_2)_n\text{-O}$, i.e., it does not contain any phenyl group thereon. However, the USPTO has indicated, pursuant to the restriction requirement, that compounds of Formula I wherein A=B=furan and the Linker is $\text{O-(CH}_2)_n\text{-O}$ is patentably distinct from the subject matter where the Linker is $\text{-O-CH}_2\text{-C}_6\text{H}_4\text{-CH}_2\text{-O-}$, which subject matter was restricted out of the claims pursuant to the restriction requirement. However, compounds wherein A=B=furan and the Linker is $\text{-O-CH}_2\text{-C}_6\text{H}_4\text{-CH}_2\text{-O-}$ is the subject matter of Wulff et al. Consequently, by its own admission, the United States Patent and Trademark Office ("USPTO") has indicated that the subject matter which, as claimed, has been amended to be consistent with the elected invention, is patentably distinct and non-obvious over the subject matter recited in the prior art, which has a Linker group containing a phenylene moiety. Further, needless to say, a Linker group containing a phenylene unit therein is structurally quite different from a linker group wherein an alkylene unit is present in its stead, and one of ordinary skill in the art understands the structural distinctiveness of the compounds of the present invention relative to the prior art and the associated activity therewith. The compounds in Wulff et al. with its phenylene ring bridge do not teach, disclose, or suggest compounds, such as the present compounds, lacking a phenylene bridge in the Linker group, but containing, alkylene units, in the absence of such a phenylene bridge. Accordingly, one of ordinary skill in the art would consider that the compounds of the present invention are patentably distinct over the prior art.

Thus, this rejection of the claimed subject matter is obviated; withdrawal thereof

is respectfully requested.

Therefore, in view of the amendment to the claims and the Remarks herein, it is respectfully submitted that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Theodore Gottlieb', written over a horizontal line.

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